

REMARKS

I. Status of claims

By this Amendment, Applicants amend claims 32, 39, and 49 and add new claims 53-61. Claims 1-61 are therefore pending in this application.

In the Office Action of May 5, 2004,¹ claims 32-43 were objected to for minor informalities; claims 1-4, 31, 32-47, and 49-52 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter; claims 1-24, 27, 29-38, 45, and 48-50 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication No. 2002/0054714 (“*Hawkins*”); claim 45 was rejected under 35 U.S.C. § 102(e) as anticipated by PCT International Publication No. WO 01/18674 A2 (“*Maloney*”); claim 28 was rejected under 35 U.S.C. § 103(a) as unpatentable over *Hawkins*; claims 25 and 26 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Hawkins* in view of AS/400 Redbook Softcopy Library image (“AS/400”); claims 39-44 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Hawkins* in view of U.S. Patent Application Publication No. 2002/0024528 (“*Lambertsen*”); claims 46 and 47 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Application Publication No. 2002/0077219 (“*Cohen*”) in view of *Maloney*; and claims 51 and 52 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Hawkins* in view of *Maloney*. Applicants address the rejections and new claims below.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

II. Objection to claims 32-43

The Examiner objected to claims 32-43 for informalities. Applicants have amended independent claims 32 and 39 to address the noted informalities and deem the objection overcome. Applicants therefore request withdrawal of the objection to claims 32 and 39, as well dependent claims 33-38 and 40-43.

III. Rejection of claims 1-4, 31, 32-47, and 49-52 under 35 U.S.C. § 101

Applicants traverse the rejection of claims 1-4, 31, 32-47, and 49-52 under 35 U.S.C. § 101 for the following reasons.

The Examiner alleged that claims 1-4, 31, 32-47, and 49-52 do not include recitations “in the technological arts.” The Examiner further alleged that the claimed invention is directed to “abstract ideas which can be performed mentally without interaction of a physical structure” and that the claims are therefore not permitted under 35 U.S.C. § 101. According to the Examiner, the “method steps may be understood as merely providing a sketch of a human face for getting assistance in a beauty store.” Applicants respectfully disagree.

According to the Federal Circuit, the inquiry of whether a claim is statutory focuses on “the essential characteristics of the subject matter, in particular, its practical utility.” *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1375 (Fed. Cir. 1998). If a claim includes recitations that produce “a concrete, tangible and useful result,” the claim is not abstract and has practical utility. *See State Street*, 149 F.3d at 1373; *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358 (Fed. Cir. 1999). And if the claim is not abstract and has practical utility, it is statutory under 35 U.S.C. § 101.

Furthermore, Applicants point out that whether or not a process can be performed “without interaction of a physical structure” is not dispositive of determining whether a claimed process is statutory. In fact, the Federal Circuit indicated that arguing that process claims are not

patentable subject matter because they lack physical limitations “reflects a misunderstanding of...[the] case law.” *AT&T*, F.3d at 1359.

Initially, Applicants point out that the Office Action fails to establish a *prima facie* showing that claims 1-4, 31, 32-47, and 49-52 are directed to “abstract ideas.” The Examiner’s conclusory statements that the claims do not “recite a limitation in the technological arts” and that the recitations “are abstract ideas which can be performed mentally without interaction of a physical structure” are wholly unsupported and do not by themselves establish that the claims are directed to abstract ideas. Furthermore, the Office Action does not specifically address the features of independent claims 31, 32, 39, 44, 45, 46, 49, and 50. In addition, the Examiner’s reasoning is insufficient because, even if the claims were interpreted as “providing a sketch . . . ,” the Office Action does not explain how “providing a sketch” would be accomplished without interaction of some physical structure. Because the allegations in the Office Action are not supported by proper evidence, the rejection of claims 1-4, 31, 32-47, and 49-52 under 35 U.S.C. § 101 should be withdrawn.

Moreover, claims 1-4, 31, 32-47, and 49-52 include recitations that produce “concrete, tangible and useful” results and, therefore, despite the Examiner’s allegations, accomplish a practical application and are not abstract. *State Street*, 149 F.3d at 1375.

Independent claim 1 recites, *inter alia*, “facilitating storage of information reflecting the subject’s usage of the beauty product.” Claim 1, at least by virtue of this feature, is not abstract and is within the technological arts. This feature is a useful, non-abstract result that facilitates, for example, viewing of the information by the subject so that the subject can appreciate the effectiveness of a beauty product. Further, “facilitating storage of information” could indeed involve interaction of a physical structure. Although, as explained above, whether or not the

claims include physical limitations is not dispositive of determining whether a claimed process is statutory. For at least the foregoing reasons, Applicants submit that claim 1 is not abstract, but rather statutory under 35 U.S.C. § 101.

Likewise, the features of independent claims 31, 32, 39, 44, 45, 46, 49, and 50 are not merely abstract ideas. In particular, these claims are not abstract at least by virtue of the following features:

Claim 31: “capturing, through a beauty facility, at least a first image of an external condition of a subject.”

Claim 32: “providing a beauty facility with technology for capturing external body condition images of a customer.”

Claim 39: “enabling a subject to record personal beauty information on a transportable medium.”

Claim 44: “enabling a beauty facility to record on transportable medium personal beauty information about a subject; [and] enabling the subject to access, at a location remote from the beauty facility, the personal beauty information.”

Claim 45: “enabling an individual to record in a data structure information about the individual’s cosmetic product usage.”

Claim 46: “enabling a subject to record in a data structure information about the subject’s cosmetic product usage and about the subject’s lifestyle; [and] comparing the recorded information with a database of information on cosmetic usage and lifestyles of a plurality of individuals.”

Claim 49: “providing instructions for storage of first information relating to an external body condition”

Claim 50: “providing instructions for storage of first information relating to an external body condition”

Each of the above-noted features produces “concrete, tangible and useful” results and could involve interaction of a physical structure. Claims 31, 32, 39, 44, 45, 46, 49, and 50 are thus not abstract. For at least the foregoing reasons, Applicants request withdrawal of the rejection of claims 1, 31, 32, 39, 44, 45, 46, 49, and 50, and their respective dependent claims 2-4, 33-38, 40-43, 47, 51, and 52, under 35 U.S.C. § 101.

IV. Rejection of claims 1-24, 27, 29-38, 45, and 48-50 under 35 U.S.C. § 102(e)

Applicants traverse the rejection of claims 1-24, 27, 29-38, 45, and 48-50 under 35 U.S.C. § 102(e) because *Hawkins* does not anticipate these claims. In order to properly anticipate Applicants’ claimed invention under 35 U.S.C. § 102(e), each and every element of the claim at issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Further, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim[s].” *See* M.P.E.P. § 2131. Finally, “[t]he elements must be arranged as required by the claim.” *Id.*

Hawkins describes a system for demonstrating the effects of cosmetic products over a period of time (Abstract). With regard to claim 1, *Hawkins* does not teach or suggest at least the “facilitating storage” feature. Although *Hawkins* mentions capturing images before and after application of a product,” (¶¶ 0039, 0041), it does not teach or suggest “facilitating storage of information reflecting the subject’s usage of the beauty product,” as claimed. *Hawkins*’s images do not constitute the claimed information reflecting the subject’s usage of a beauty product (e.g., frequency of usage, intensity of usage, etc.). Further, while *Hawkins* mentions that an image of a body part can be “digitally transformed . . . to demonstrate effects of a cosmetic product treatment” (¶¶ 0043-0044), this functionality does not anticipate “facilitating storage of

information reflecting the subject's usage of the beauty product.” Contrary to the Examiner's assertion (OA at 3), transforming an image to demonstrate predicted effects of a product, as mentioned by *Hawkins*, is not consistent with storing information reflecting the subject's usage of a beauty product, as claimed. For at least the foregoing reasons, *Hawkins* fails to anticipate the “facilitating storage” feature of claim 1.

Because *Hawkins* does not teach or suggest each and every feature of claim 1, as a matter of law, it cannot anticipate claim 1. As such, the rejection of claim 1 under 35 U.S.C. §102(e) based on *Hawkins* should be withdrawn.

Similar to claim 1, independent claim 5 recites, *inter alia*:

facilitating capture and storage of information reflecting usage of at least one of the beauty products by the subject, the usage occurring on at least one occasion between capture of the first image and capture of the second image.

Also similar to claim 1, independent claim 48 recites, *inter alia*:

facilitating capture and storage of information reflecting usage of at least one of the cosmetic products by the subject, the usage occurring on at least one occasion between capture of the first image and capture of the second image.

While claims 5 and 48 are of different scope than claim 1, *Hawkins* does not anticipate independent claims 5 and 48 for at least reasons similar to those presented above in connection with claim 1.

Independent claim 31 recites, *inter alia*: “establishing a subject record, the record including the first image; associating . . . at least one second image with the subject record; and providing the subject with viewing access to the subject record.” *Hawkins* fails to teach or suggest at least the above-noted features. Although *Hawkins* mentions “capturing” images, (¶¶ 0039, 0041), it does not teach or suggest at least “establishing a subject record,” as claimed. *Hawkins* thus cannot anticipate claim 31.

Independent claim 45 recites, *inter alia*:

enabling the individual to record in the data structure personal information, other than the cosmetic product usage information, the personal information including at least one of lifestyle information, information about physical characteristics of the individual, fashion preferences, area of residence, vacation patterns, and climate and weather conditions at areas of vacation and residence;

enabling an individual to update in the data structure cosmetic product usage information and personal information; [and]

enabling the data structure to maintain a historical record of at least some of the recorded cosmetic product usage information and personal information.

Hawkins does not teach or suggest the above-noted features and therefore cannot anticipate claim 45. In fact, the Office Action does not specifically address the features of claim 45 in the rejection.

Independent claim 49, as currently presented, recites, *inter alia*:

analyzing the first and second information to determine an extent of differences that occurred in the body condition between the first and second time frames; and

prescribing at least one beauty product based on the extent of determined differences.

Hawkins does not teach or suggest the above-noted features. Although *Hawkins* mentions “allowing the consumer to compare results between . . . images” (§ 0042), the reference does not teach “analyzing . . . first and second information to determine an extent of differences that occurred in the body condition,” as claimed. Further, contrary to the Examiner’s allegations, “digitally [transforming an image] . . . to demonstrate [predicted] effects of a cosmetic product treatment” (§§ 0043-0044) does not anticipate “analyzing . . . first and second information to determine an extent of differences that occurred in the body condition,” as claimed. In

Hawkins's system, an image is transformed to demonstrate a predicted effect, not to analyze information to *determine* an extent of differences that occurred in the body condition.

Additionally, *Hawkins* does not teach or suggest the claimed "prescribing." As the Examiner notes (OA at 4), *Hawkins* mentions providing "[c]ustomized product information" to aid consumers in achieving an "ideal." (§ 0053). *Hawkins* does not, however, teach or suggest providing this customized product information based on "the extent of determined differences [that occurred in the body condition between first and second time frames]," as recited in claim 49. For at least these reasons, *Hawkins* does not teach or suggest "prescribing at least one beauty product based on the extent of determined differences." *Hawkins*, accordingly, cannot anticipate claim 49.

Independent claim 50 recites, *inter alia*:

providing instructions for storage of third information relating to behavior of a subject between the first and second time frames.

Hawkins does not teach or suggest the above-noted features. Although *Hawkins* mentions "capturing" images before and after usage of a product (§§ 0039, 0041), it does not teach or suggest "storing information relating to behavior of a subject between . . . first and second time frames," as claimed. Because *Hawkins* does not teach or suggest each and every feature of claim 50, as a matter of law, it cannot anticipate claim 50.

With regard to independent claim 32, the Examiner alleged that "[s]electing the cosmetic product at the sales counter . . . inherently indicates distributing said cosmetic product to the point of sale [and] . . . use of said method, disclosed by *Hawkins*, inherently indicates instructing a business entity to perform said method steps" (OA at 4). The Examiner has not established inherency.

As M.P.E.P. § 2112 makes clear:

To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" (internal citations omitted).

In addition, M.P.E.P. § 2112 states:

[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. (internal citations omitted).

The Office Action fails to provide sufficient evidence from *Hawkins*, or any recourse to extrinsic evidence, that makes clear that the subject matter of claim 32 is necessarily present in the reference. Further, the Office Action fails to present sufficient factual basis and technical reasoning to demonstrate inherency. That *Hawkins* allegedly mentions “[s]electing the cosmetic product at the sales counter” does not evidence that the recitation of “distributing at least one cosmetic product to the beauty facility” is necessarily present in *Hawkins*. In addition, the Office Action provides no factual basis and technical reasoning to support the allegation that use of *Hawkins*’s method indicates instructing a business entity to perform the method. Consequently, the Examiner cannot properly infer that the subject matter of claim 32 is inherently disclosed by *Hawkins*.

Because *Hawkins* fails to anticipate claims 1, 5, 31, 32, 45, 48, 49, and 50, the rejection of these independent claims under 35 U.S.C. § 102(e) based on *Hawkins* should be withdrawn. The rejection of claims 2-4, 6-24, 27, 29, 30, and 33-38 should be withdrawn as well, at least because of the respective dependence of those claims from independent claims 1, 5, and 32. Applicants thus request withdrawal of the rejection of claims 1-24, 27, 29-38, 45, and 48-50 and the timely allowance of these claims.

V. Rejection of claim 45 under 35 U.S.C. § 102(e)

Applicants traverse the rejection of claim 45 under 35 U.S.C. § 102(e) because *Maloney* does not anticipate these claims. Claim 45 recites, *inter alia*:

enabling the data structure to maintain a historical record of at least some of the recorded cosmetic product usage information and personal information; and

causing at least one product to be recommended to the individual, wherein the at least one product recommendation is generated using at least a portion of the historical record.

Maloney fails to anticipate at least the above-noted features. Although *Maloney* mentions collecting profiling data (pages 6-7), the reference does not teach or suggest enabling a data structure to maintain “a historical record of at least some of the recorded cosmetic product usage information and personal information,” as claimed. Furthermore, *Maloney*’s profiling data does not include “product usage information.” *Maloney* merely mentions collecting “preferred colors and styles, lifestyle, life stage, attitude, desired look of hair, desired look of face and level of involvement” (page 7).

Maloney also fails to disclose causing “at least one product recommendation [that] is generated using at least a portion of the historical record,” as claimed. In *Maloney*’s system, a user “is provided with a list of one or more products ... that correspond to the consumer profiling category” (pgs. 7, 9). This functionality of *Maloney* is not consistent with “using at least a portion of a historical record,” which includes recorded cosmetic product usage information and personal information, to generate at least one product recommendation, as claimed. Because *Maloney* does not teach or suggest each and every feature of claim 45, as a matter of law, *Maloney* cannot anticipate claim 45. Applicants thus request withdrawal of the rejection of claim 45 under 35 U.S.C. § 102(e) and the timely allowance of this claim.

VI. Rejection of claim 28 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claim 28 under 35 U.S.C. § 103(a) based on *Hawkins* because *prima facie* obviousness has not been established with respect to these claims. To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. First, the applied references, taken alone or in combination, must teach or suggest each and every element recited in the claims. *See* M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001).

The Examiner conceded (OA at 6) that *Hawkins* fails to disclose:

encouraging the beauty facility to recommend to the subject that the subject capture and store the second image on the recordable media at a location remote from the beauty facility.

In rejecting claim 28, the Examiner alleged that it would have been obvious to a skilled artisan to modify *Hawkins* to include the missing feature “because it would be convenient for the consumer to take the second image at the time suitable for the consumer” (OA at 7).

Claim 28 depends from claim 5. *Hawkins* does not teach or suggest each and every feature of base claim 5, as explained above, and thus fails to teach or suggest each and every feature of dependent claim 28. In addition, as affirmed by the Examiner, *Hawkins* fails to teach or suggest the above-noted “encouraging” feature of claim 28.

Moreover, the requisite motivation for modifying *Hawkins*, as alleged by the Examiner, is lacking. Determinations of obviousness must be supported by evidence on the record. *See In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to

the issue of patentability, including conclusions of obviousness by the Board, must be supported by “substantial evidence”).

In this case, the Office Action provides no “substantial evidence” to support the attempted modification of *Hawkins*. For example, the Office Action does not show, by substantial evidence, that a skilled artisan considering *Hawkins*, and not having the benefit of Applicants’ disclosure, would have been motivated to modify the reference in a manner resulting in Applicants’ claimed combination. The Examiner merely alleges that a skilled artisan would have modified *Hawkins* “because it would be convenient for the consumer to take the second image at the time suitable for the consumer.” This conclusory allegation is not properly supported by evidence on the record and does not establish that a skilled artisan would have been motivated to combine the references. For example, the Examiner points to no mention in *Hawkins* of the alleged consumer convenience. The Office Action does not show the alleged motivation to be present in *Hawkins* or in the knowledge generally available to one skilled in the art. Applicants submit that the conclusions in the Office Action pertaining to motivation were not reached based on facts gleaned from the cited references and that, instead, teachings of the present application were improperly used to reconstruct the prior art.

For at least the foregoing reasons, *prima facie* obviousness has not been established with respect to claim 28. Applicants thus request withdrawal of the rejection of claim 28 under 35 U.S.C. § 103(a) and the timely allowance of this claim.

VII. Rejection of claims 25 and 26 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claims 25 and 26 under 35 U.S.C. § 103(a) based on *Hawkins* and AS/400 because *prima facie* obviousness has not been established with respect to these claims.

Claims 25 and 26 depend from base claim 5 and therefore include all of the features of base claim 5. As discussed above, *Hawkins* does not teach or suggest each and every feature of claim 5. In particular, *Hawkins* does not teach or suggest “providing instructions for storage of third information relating to behavior of a subject between the first and second time frames,” as claimed. *Hawkins* therefore fails to teach or suggest each and every feature of dependent claims 25 and 26. In addition, AS/400 does not cure the deficiencies of *Hawkins*. Neither *Hawkins* nor AS/400, nor any combination thereof, teaches or suggests all of the elements of claims 25 and 26 and, for at least this reason, the rejection of these claims as unpatentable over these references should be withdrawn. Accordingly, Applicants request withdrawal of the rejection of claims 25 and 26 under 35 U.S.C. § 103(a) and the timely allowance of these claims.

VIII. Rejection of claims 39-44 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claims 39-44 under 35 U.S.C. § 103(a) based on *Hawkins* and *Lambertsen* because *prima facie* obviousness has not been established with respect to these claims.

With regard to independent claim 39, the Examiner appears to concede (OA at 7) that *Hawkins* fails to disclose:

enabling a subject to record personal beauty information on a transportable medium; [and]

enabling a plurality of beauty facilities to read the information on the transportable medium, and to update the information when the subject visits one or more of the plurality of beauty facilities.

In rejecting claim 39, the Examiner relied on *Lambertsen* in an attempt to cure *Hawkins*’s deficiencies.

A *prima facie* case of obviousness has not been established with respect to claim 39 because, as affirmed by the Examiner, *Hawkins* fails to teach or suggest each and every claimed

feature and, contrary to the Examiner's position, *Lambertsen* fails to cure *Hawkins*'s deficiencies.

Lambertsen is directed to a virtual makeover system. *Lambertsen* does not teach or suggest at least "enabling a subject to record personal beauty information on a transportable medium," as recited in claim 39. The relied upon portions of *Lambertsen* merely mention an application stored on a CD-ROM (§ 0002) and uploading images from a photo CD image file (§ 0038). The disclosures of a CD-ROM application and uploading .pcd images, however, do not teach or suggest enabling a subject to record personal beauty information (e.g., dosage, application frequency, duration of use, etc.) on a transportable medium.

Further, *Lambertsen* does not teach or suggest "enabling a plurality of beauty facilities to read . . . [recorded beauty] information on . . . [a] transportable medium, and to update the information when the subject visits one or more of the plurality of beauty facilities," as claimed. Although *Lambertsen* mentions that service providers can access the virtual makeover system, the reference does not teach or suggest that those service providers can update beauty information recorded on a transportable medium when the subject visits one or more of the service providers. Accordingly, neither *Hawkins* nor *Lambertsen*, nor any combination thereof, teaches or suggests each and every feature of claim 39.

Regardless of whether *Lambertsen* cures *Hawkins*'s deficiencies, a *prima facie* case of obviousness has not been established with respect to claim 39 because the requisite motivation to combine *Hawkins* and *Lambertsen* is lacking. As noted above, determinations of obviousness must be supported by evidence on the record. See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by "substantial evidence"). Further,

the desire to combine references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52).

The Office Action does not show, by substantial evidence, that a skilled artisan considering the cited references, and not having the benefit of Applicants’ disclosure, would have been motivated to combine the references in a manner resulting in Applicants’ claimed combination. Again, Applicants submit that the conclusions in the Office Action were not reached based on facts gleaned from the cited references and that, instead, Applicants’ claims were improperly used to reconstruct the prior art.

Independent claim 44 recites, *inter alia*, “enabling a beauty facility to record on transportable medium personal beauty information about a subject.” As conceded by the Examiner (OA at 8), *Hawkins* fails to disclose this feature. For reasons similar to those presented above for claim 39, *Lambertsen* fails to cure *Hawkins*’s deficiencies and the required motivation to combine the references is lacking.

For at least the foregoing reasons, the rejection of independent claims 39 and 44 under 35 U.S.C. § 103(a) should be withdrawn. The rejection of claims 40-43 should be withdrawn as well, at least because these claims depend from base claim 39. Applicants thus request withdrawal of the rejection of claims 39-44 under 35 U.S.C. § 103(a) and the timely allowance of these claims.

IX. Rejection of claims 46 and 47 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claims 46 and 47 based on *Cohen* and *Maloney* for at least the following reasons.

Initially, Applicants submit that *Cohen* is nonanalogous art and therefore an improper reference against the Applicants’ claims under 35 U.S.C. § 103(a). *Cohen* is not in the same

field of endeavor as Applicants' claimed invention. *Cohen* relates to incentivizing use of exercise equipment and is dissimilar to claims 46 and 47, which are directed to a beauty advisory method. Further, *Cohen* is not reasonably pertinent to the particular problem addressed by claims 46 and 47. That is to say, *Cohen* would not logically have commended itself to an inventor's attention in considering the problems associated with cosmetic product usage and providing beauty advice to subjects. *Cohen* thus should be regarded as nonanalogous art and should not be used as a reference against the present application under 35 U.S.C. § 103(a). See M.P.E.P. § 2141.01(a).

Moreover, claim 46 recites, *inter alia*:

comparing the recorded information [about the subject's cosmetic product usage and about the subject's lifestyle] with a database of information on cosmetic usage and lifestyles of a plurality of individuals; [and]

causing, when the subject's cosmetic usage is inconsistent with the cosmetic usage of individual's with lifestyles similar to the subject's lifestyle, at least one product to be recommended to the subject.

Neither *Cohen* nor *Maloney*, nor any combination thereof, teaches or suggests the above features.

Although *Cohen* mentions "[u]sage-based pricing of equipment," the reference does not appear to teach or suggest the claimed "comparing." Further, *Cohen* does not disclose or suggest "causing, when the subject's cosmetic usage is inconsistent with the cosmetic usage of individual's with lifestyles similar to the subject's lifestyle, at least one product to be recommended to the subject," as claimed.

Maloney does not cure *Cohen*'s deficiencies. *Maloney* mentions determining a profiling category for a consumer based on profiling information and providing a list of products corresponding to the category (pgs. 7, 9). *Maloney* fails to disclose causing a product to be recommended to a subject "when the subject's cosmetic usage is inconsistent with the cosmetic

usage of individual's with lifestyles similar to the subject's lifestyle," as claimed. Accordingly, *Cohen* and *Maloney* (taken alone or in combination) do not teach or suggest each and every feature of claim 46 and, for at least this reason, *prima facie* obviousness has not been established with respect to these claims.

Further, the requisite motivation to combine *Cohen* and *Maloney* is lacking. The Examiner has not shown that a skilled artisan considering the cited references, and not having the benefit of Applicants' disclosure, would have been motivated to combine the references. Applicants submit that the conclusions in the Office Action were not reached based on facts gleaned from the cited references and that, instead, Applicants' claims were improperly used to reconstruct the prior art.

For at least the foregoing reasons, the rejection of claim 46 under 35 U.S.C. § 103(a) should be withdrawn. The rejection of claim 47 should also be withdrawn, at least because this claim depends from base claim 46. Applicants therefore request withdrawal of the rejection under 35 U.S.C. § 103(a) and the timely allowance of these claims.

X. Rejection of claims 51 and 52 under 35 U.S.C. § 103(a)

Claims 51 and 52 depend from base claim 50 and therefore include all of the features recited in base claim 50. As discussed above, *Hawkins* does not teach or suggest "providing instructions for storage of third information relating to behavior of a subject between the first and second time frames," as recited in claim 50. *Hawkins* therefore does not teach or suggest each and every feature of dependent claims 51 and 52. In addition, *Maloney* does not cure the deficiencies of *Hawkins*. Neither *Hawkins* nor *Maloney*, nor any combination thereof, teaches or suggests all of the features of claims 51 and 52. For at least this reason, Applicants request withdrawal of the rejection of claims 51 and 52 under 35 U.S.C. § 103(a).

XI. New claims 53-61

Each of new claims 53-61 depends directly or indirectly from claim 1, 5, 32, 39, 44, or 49. Applicants submit that these new claims are allowable at least by virtue of such dependency. Further, neither *Hawkins*, *Maloney*, AS/400, *Lambertsen*, nor *Cohen*, nor any combination thereof, teaches or suggests all of the features of new claims 54-61. Applicants therefore request the timely allowance of the new claims.

XII. Conclusion


The claimed invention is neither anticipated nor rendered obvious in view of the references cited against this application. Applicants request the Examiner's reconsideration of the application in view of the foregoing, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: September 3, 2004

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